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10/575,131	02/12/2007	Darren J. Carroll	24195-521 NATL	9352
35437 7590 03/22/2010 MINTZ LEVIN COHN FERRIS GLOVSKY & POPEO ONE FINANCIAL CENTER BOSTON, MA 02111				
EXAMINER McCORMICK, GABRIELLE A				
ART UNIT		PAPER NUMBER		
3629				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/575,131

Applicant(s)

CARROLL, DARREN J.

Examiner

Gabrielle McCormick

Art Unit

3629

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 February 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☒ Claim(s) 10 and 12 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/CDC)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date _____

DETAILED ACTION

Status of Claims

1. This action is in reply to the application filed on February 12, 2007.
2. Claims 1-13 are currently pending and have been examined.

Claim Objections

3. Claim 10 is objected to for containing more than one period. ("...solution criteria. award..")
4. Claim 12 is objected to for an improper tense of the verb "include". The claim will be understood as "wherein the prompts further **include** a discipline..."

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 1-13 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
7. Claim 1 is a system claim with a preamble that recites "a template driven interface". The functionality of the interface of enabling selection, prompting, receiving, generating and posting does not distinguish the system from the prior art. A system is distinguished from prior art in terms of structure. Therefore, as the system is solely claimed as a template driven interface, it is unclear how the interface is capable of generating a challenge or posting the challenge as the structure presumed to be associated with these tasks is not claimed.
8. Claim 1 further recites "a network accessible". It is unclear whether this is a particular type of network or an incomplete phrase.

9. Claim 2 recites the phrases "the desire information" and "the all entered information"; claim 3 recites "the information entered"; claim 4 recites "the information"; claim 5 recites "the format" and "the document"; claim 7 recites "the system operator". These terms lack proper antecedent basis.
10. Claim 11 is unclear as to how the attachment prompt can provide a user.

Claim Rejections - 35 USC § 101

11. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

12. Claims 1-13 are rejected under 35 U.S.C. 101 because they lack the necessary physical articles or objects to constitute a machine or a manufacture within the meaning of 36 USC 101. They are clearly not a series of steps or acts (i.e., a process) nor are they a combination of chemical compounds (i.e., composition of matter). As such, they fail to fall within a statutory category. They are, at best, function descriptive material *per se*.
13. Descriptive material can be characterized as either "functional descriptive material" or "nonfunctional descriptive material." Both types of "descriptive material" are nonstatutory when claimed as descriptive material *per se*, (33 F.3d at 1360, 31 USPQ2d at 1759). When functional descriptive material is recorded on some computer-readable medium, it becomes structurally and functionally interrelated to the medium and will be statutory in most cases since use of technology permits the function of the descriptive material to be realized. Compare *In re Lowry*, 32 F3d 1579, 1583-84, 32 USPQ2d 1031, 1035 (Fed. Cir. 1994).
14. Merely claiming nonfunctional descriptive material, i.e., abstract ideas, stored on a computer-readable medium, in a computer, or on an electromagnetic carrier signal, does not make it statutory. See *Diehr*, 450 U.S. at 185-86, 209 USPQ at 8 (noting that the claims for an algorithm in *Benson* were unpatentable as abstract ideas because "[t]he sole practical application of the algorithm was in connection with the programming of a general purpose computer.").

15. Claim 1 is a system that comprises "a template driven interface" that enables further actions. The "template driven interface" is understood to be a software application and therefore does not recite structural elements.
16. Additionally, claim 11 recites "a user" which is non-statutory subject matter. As a result, it is read to claim human beings themselves, which are non-statutory subject matter and are therefore barred from patentability. The applicant can amend the claim to include some structure that allows for the human interaction with the system and therefore claims the structure and not the human beings.

Claim Rejections - 35 USC § 103

17. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

18. **Claims 1-13** are rejected under 35 U.S.C. 103(a) as being unpatentable over Bernardo et al. (US Pat. No. 6,185,587, hereinafter referred to as "Bernardo") in view of Innocentive.com (pages retrieved from the Internet Archive from July 20, 2002).
19. **Claims 1 and 8:** Bernardo discloses a tool that determines which templates should be used from a list of stored templates to prompt a user to supply data to populate the fields of the template. The template results in creating web pages that are posted on the Internet. (C2; L58-C3; L5). The user is prompted to select whether to create a new site or edit an existing one. (C7; L18-20). A graphic interface and selection device is disclosed (C7; L44-48) and the user is prompted to enter certain data to complete the template fields (C7; L60-61), including identification information (C7; L63-64: company name, contact information).
20. Bernardo does not disclose challenges, seekers and solvers.

21. Innocentive.com, however, discloses challenges, seekers and solvers.
22. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have included challenges, seekers and solvers, as disclosed by Innocentive.com in the system disclosed by Bernardo, for the motivation of providing a method of building a website using specific terminology and directed to the business of matching employers/companies (i.e., seekers) to resources (i.e., solvers).
23. Further, the types of prompts and names of authors and targets of web pages is **nonfunctional descriptive data** and are not functionally involved in the steps recited. **The creation of the web page for posting would be performed regardless of the information prompted and the names of the authors and targets.** Thus, this descriptive data will not distinguish the claimed invention from the prior art in terms of patentability, *see In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).
24. **Claims 2 and 4:** Bernardo discloses a previewing capability (C10; L11-13); making changes and saving in a specified format. (C8; L62-C9; L29).
25. **Claim 3:** Bernardo discloses previewing (C10; L11-13) and links (i.e., a list of attachments) (C10; L51-54).
26. **Claim 5:** Bernardo discloses that web pages and documents are stored for retrieval and updating (C10; L24-39). In storing, the specification of a format (i.e., a file extension), location and name are inherent.
27. **Claims 6 and 13:** Bernardo discloses updating an existing web site (C8; L34-38).
28. **Claim 7:** Bernardo discloses posting to the Internet based on Webmaster's assignment of roles. (C19; L30-49).
29. **Claims 9, 10, 11 and 12:** Bernardo discloses prompting the user to supply data into a template (C2; L62-67) but does not disclose background, detailed information, attachment or discipline specification prompts.
30. Innocentive.com, however, discloses challenges viewable by a web site in formatted to be consistent from one challenge to the next (thus it is obvious to use the template and prompts of

Bernardo it generate the challenges posted on Innocentive.com) where information including related background information, award information, and discipline (i.e., "chemistry") is provided (see "InnoCentive – InnoCentive Challenge List"). Further, a "More" tab is available that makes it obvious that the ability to attach documents is provided. Bernardo discloses providing links and that a web site has information areas that include "product descriptions, product reviews, spec sheets, policy guides..." (C19; L20-25). It is obvious to prompt to attach documents as this is old and well known in the art. For example, attachment prompts are commonly available in email applications.

31. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have included specific prompts, as disclosed by Innocentive.com in the system disclosed by Bernardo, for the motivation of providing a method of building a website using specific terminology and directed to the business of matching employers/companies (i.e., seekers) to resources (i.e., solvers).
32. Further, the types of prompts are **nonfunctional descriptive data** and are not functionally involved in the steps recited. **The creation of the web page for posting would be performed regardless of the information prompted.** Thus, this descriptive data will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).

Double Patenting

33. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

34. A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.
35. Claims 1-13 are provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1-13 of copending Application No. 10/573298. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

Requirement for Information Under 37 C.F.R. § 1.105

36. Applicant and the assignee of this application are required under 37 CFR 1.105 to provide the following information that the examiner has determined is reasonably necessary to the examination of this application.
37. The information is required to identify publications, the public sale or use embodying the disclosed subject matter of a system comprising a template driven interface for enabling seekers to create and post challenges for solvers in over a network.
38. The Examiner upon conducting a search for prior art discovered the website www.innocentive.com retrieved from the Internet Archive from July 20, 2002.
39. The website pages disclose the outcome of the creation and posting process that results in "challenges" being posted by "seekers" and awarded to "solvers".
40. In response to this requirement, please provide any known publications, brochures, manuals and press releases that describe InnoCentive.com's services and/or products that were the subject of the website. Please include any material that describes:
- The creation of challenges via a template driven interface that prompts for user input.
41. Further, please provide the names and descriptions of any products or services that have incorporated the claimed subject matter, as of and subsequent to July 2002.

42. In responding to those requirements that require copies of documents, where the document is a bound text or a single article over 50 pages, the requirement may be met by providing copies of those pages that provide the particular subject matter indicated in the requirement, or where such subject matter is not indicated, the subject matter found in applicant's disclosure.
43. The fee and certification requirements of 37 CFR 1.97 are waived for those documents submitted in reply to this requirement. This waiver extends only to those documents within the scope of this requirement under 37 CFR 1.105 that are included in the applicant's first complete communication responding to this requirement. Any supplemental replies subsequent to the first communication responding to this requirement and any information disclosures beyond the scope of this requirement under 37 CFR 1.105 are subject to the fee and certification requirements of 37 CFR 1.97.
44. The applicant is reminded that the reply to this requirement must be made with candor and good faith under 37 CFR 1.56. Where the applicant does not have or cannot readily obtain an item of required information, a statement that the item is unknown or cannot be readily obtained may be accepted as a complete reply to the requirement for that item.
45. This requirement is an attachment of the enclosed Office action. A complete reply to the enclosed Office action must include a complete reply to this requirement. The time period for reply to this requirement coincides with the time period for reply to the enclosed Office action.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gabrielle McCormick whose telephone number is (571)270-1828. The examiner can normally be reached on Monday - Thursday (5:30 - 4:00 pm).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on 571-272-6812. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/G. M./
Examiner, Art Unit 3629

/JOHN G. WEISS/
Supervisory Patent Examiner, Art Unit 3629